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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,890	03/08/2001	Takashi Yamane	1086.1142	6818

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,890

Applicant(s)

YAMANE ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-16, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-16, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/23/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Applicant's election without traverse of claims 1-4, 7-16 and 20-21 in the reply filed on 6/24/2004 is acknowledged. Claims 5-6 and 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/24/2004. Note: In the previous Office action "claims 9-12" on page 3 included a typographical error because the examiner meant claim 6 and not claims 9-12 as the claim 6 recites the sales article consisting of a packaged video recording medium. Accordingly, claim 6 falls in the group of withdrawn claims and claims 9-12 in the group of elected claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.1. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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2.2. Claims 1-3, 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes et al. (US Publication 2002/0023015 A1), hereinafter, referred to Hughes.

Regarding claims 1-3, Hughes anticipates an electronic commerce method of a server for performing a commerce with a client by using a network (see Figs. 1 thru 3 which disclose a client-server architecture for conducting electronic commerce using a network [Internet 10] , comprising:

an order receiving step which separates a sales article into information and goods and presents them to the client in a form such that they can be selected; and an article providing step which selects the separated information, the separated goods, or a combination thereof on the basis of an ordering request from said client and provides it to said client (see at least paragraphs 0020-0049 on pages 2-6 which disclose the Hughes discloses presenting both downloadable digital data , such as songs [see at least Figs. 6A and 6B] as well as physical storage media , such as CD or Cassettes [see at least Figs. 6c and 6d]. The downloadable data corresponds to " separated information" and physical storage media , such as CD or Cassettes corresponds to " separated goods" as claimed in the instant application. See also all the Figures of Hughes which illustrate the Hughes invention and reads on the limitations of claim 1 of the instant application).

Regarding claims 2 and 3 Hughes discloses that in claim 1, the said article providing step comprises, a time difference service such that after the separated information was precedently provided, the separated goods are provided is executed and in said article providing step, a separation service such that the separated information and the separated goods are respectively solely provided is executed (see at least paragraphs 044-049 on pages 5-6 which disclose that the downloadable data,

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that is songs can be downloaded while ordering and the separated goods consisting of CD or cassettes are shipped by regular channels, which could be UPS, courier service or USPS and also the execution of the orders is done separately).

Regarding claims 15 and 20, their limitations are closely parallel to the limitations of claim 1 and are therefore analyzed and rejected on the basis of same rationale.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes and further in view of Dockes et al. (US Patent 6,011,758), hereinafter, referred to as Dockes.

Regarding claim 4, Hughes discloses a method according to claim 1, wherein said sales article is a packaged music recording medium, in said order receiving step, said packaged music recording medium is separated into recorded music piece data, a package, music, and the recording medium itself and presented, and in said article providing step, the packaged music recording medium, the music piece data, the music, the recording medium, or a combination thereof is selected and provided to said client (see at least Figs. 6C and 6D and paragraphs 0038-0047 on pages 4-5, which disclose that the said sales article "Yield" is a packaged recording medium in a CD or

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Cassette or Mini Disc, etc. and is packaged from a separated recorded music consists of recorded music piece data, a package, music, and the recording medium and is presented and provided to the buyer).

Hughes does not disclose a medium casing. However, Dockes in the field of same endeavor, that is producing customized CD, discloses a medium casing to be provided with the ordered recording medium(see at least abstract, col. 3, lines 36-40, where the jacket corresponds to the medium casing). In view of Dockes, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Hughes to incorporate the feature of including a medium casing as a component to be provided with the CD or recording medium because it enables to cover the recording medium and include description/identification on it relating to the contents of the music.

3.1. Claims 7-14, 16 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Hughes in view of Gracenote (Press release, "" " Gracenote Digital Top"- First to Accurately chart global listening trends"; October 12, 2000 extracted from the Gracenote Website on Internet on 1/23/2005) and further in view of Official Notice.

Regarding claims 7-14, Hughes discloses further comprising providing form analyzing step which is presented as a default to client (see at least Figs 8C-8E which describes providing a form to obtain client's selection and data required to download information-[songs]) and registering the user's information [see at least Fig. 4, "44 A Registration Module " and Fig. 8A) but does not disclose the following limitations:

obtain a use frequency and a storing time of an article as a target to be ordered and sets said providing form, providing form analyzing step when the use frequency of the article is low and the storing time is short, a providing form of only the information is set/ when the use frequency of the article is high and the storing time is long, a

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providing form of the goods themselves is set./ when the use frequency of the article is high and the storing time is short, a providing form of a combination of the information and the goods is set / when the storing time is long although the use frequency of the article is low, a providing form of a combination of the information and the goods or a providing form of the goods themselves is set/ wherein in said providing form analyzing step, the use frequency and the storing time for the article ordered by said client are obtained with reference to a database of user information in which use environments, tastes, and the like have previously been registered/ wherein in said providing form analyzing step, the use frequency and the storing time for the article ordered by said client are obtained with reference to a database in which a use frequency and a storing time have previously been registered in correspondence to an attribute of the sales article. Note: All of these limitations correspond to collecting data from the consumers for different situations related to their preferences to analyze and predict the future requirements for downloadable information, such as songs & music as well as non-downloadable merchandizes, such as CD and this collected data is used in analyzing and formulating charts/statistical tools to helps the merchants to plan, manufacture and sell their products in the most efficient and profitable manner. The reference Gracenote teaches the concept of aggregating data about the user's activities as regards to the frequency of using/listening to a particular information/songs of an album/CD all over the world and quantifies the frequency of use of information/songs into a measure of popularity (see the full article, " Gracenote's Digital Top 10 is the most accurate measurement of what wired fans everywhere are listening to on their computers," said David Hyman, president of Gracenote. "We are the only company that can quantify the new ways people are listening to music by measuring listening habits across multiple media players.....". Note: The time duration considered in weeks or months or years

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to determine the measure of popularity of songs relates to the storage time).

Gracenot also discloses as an admitted prior art the concept of aggregating data about the user's activities as regards to the frequency of use and sales of physical CD to quantify the compiled data into a measure of popularity (see at least "" *This changes the playing field for artists who may traditionally be number one on the charts based upon physical CD sales but are now being bumped by lesser known artists played more frequently in the digital world,*" adds Hyman.). The time duration considered in weeks or months

or years to determine the measure of popularity of songs relates to the storage time). In view of Gracenote, it would have been obvious to one of an ordinary skilled in the art to incorporate the features of aggregating data/feedback from the users in forms/formats related to the measure of frequency of use of information or articles, such as CD's sold in a particular storage time to predict the trends of the consumer's preferences and thereby helping music/album/cds' producers to efficiently and profitable manufacture/sell/distribute their products, both the articles, such as CDs' and information, that is downloadable music as suggested in Gracenote (see at least ,

".....Gracenote's platform is designed for makers of media players and encoders, consumer electronic manufacturers, record companies, and on and off-line consumer brands. **Its network of technology and services creates new sources of revenue and increases demand for their products or services, and opens new direct interactive channels to online music fans worldwide. More than 1000 media players worldwide, serving more than one million consumers daily, rely on Gracenote's Disc Recognition System (DRS) services, the most accurate, scaleable and reliable compact disc recognition service.** ").

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Regarding claims 16 and 21, there limitations are closely parallel to the limitations of claim 7 and are therefore analyzed and rejected on the basis of same rationale.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) Gillespie Nick; "Cutting out the middlemen"; Reason; Los Angeles; Aug/Sep 2000; vol: 32; Iss: 4; Page 4; 2 pages; extracted on Internet from Proquest database discloses downloading songs and ordering physical CD's with recorded music and jacket (see at least paragraph 8 on page 2).

(ii) US Patent 6,233,682 to Fritsch (see at least abstract, col.2, line 57-col.3, line 13, col.7, lines 4-26) and US Patent 6,317,722 to Jacbi et al. (see at least abstract and col.2, lines 33-56) disclose receiving order for items which can be split into physical goods, such as CD or downloadable information, such as songs fro a server and also aggregating data of the user's preferences, such as frequency of listening to a particular song or selling a particular CD.

(iii) US Patent 6,334,127 to Bieganski et al. discloses a computerized system which compiles data of the users about their past history and then analyzes the data to predict goods/targets that a user is likely to purchase (see at least col.1, line 35-col.2, line 67).

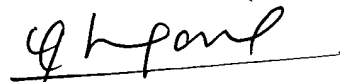
US Patent 6,834,110 to Marconcini et al. (see at least abstract and col.61, line 15-col.66, line 28) disclose a method using a client-server architecture and a communication network to enable a client order items which includes both downloadable information and physical merchandize.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
January 21, 2005